

REMARKS/ARGUMENTS

Claims 1, 2, 5-14, 19-22, 28, 29, and 44-58 are pending in the application. The Applicant hereby requests further examination and reconsideration of the application in view of these remarks.

Art Rejections

In paragraph 2 of the office action, the Examiner rejected claims 1, 2, 5-7, 9, 10, 12, 13, 19-22, 28, 29, 44, 45, 47-50, 52-55, 57, and 58 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,640,987 ("Tsukada") in view of U.S. Patent No. 5,140,628 ("Murata"). In paragraph 3, the Examiner indicated that claims 8, 11, 14, 46, 51, and 56 would be allowable if rewritten in independent form.

For the following reasons, the Applicant submits that all of the pending claims are allowable over the cited references.

Claims 1, 2, 5, 19-22, 28, and 29

Claim 1 recites:

1. A method of answering an incoming call at a cordless telephone having a base unit and a plurality of cordless handsets, each of said base unit and plurality of cordless handsets being at a different location, the method comprising the steps of:

answering, by a first party, the incoming call at one of said plurality of cordless handsets;

after the incoming call is answered and while the incoming call is active, initiating an intercom connection between cordless handsets, by an intercom initiating party, to alert an intercom receiving party, the intercom connection permitting voice communication between the intercom initiating party and the intercom receiving party;

automatically placing said incoming call in a hold status if either said intercom initiating party or said intercom receiving party is also said first party; and

accepting said incoming call at another one of said plurality of cordless handsets, by said intercom receiving party, by terminating the hold status.

In rejecting claim 1, the Examiner acknowledged that Tsukada fails to disclose: (i) "answering an incoming call at a cordless telephone having a base unit and a plurality of cordless handsets," (ii) "initiating an intercom connection between cordless handsets," and (iii) "accepting [an] incoming call [at] another one of [the] plurality of cordless handsets." However, the Examiner alleged that Murata teaches all of these features, concluding that "it would have been obvious to one of ordinary skill in the art at the time [the] invention was made to apply the teaching of Murata to Tsukada to [make it] easy for controlling an intercom connection among a plurality of the radio telephone handsets."

However, even the combined teachings of the Tsukada and Murata references are severely deficient and fail to render the Applicant's claim 1 obvious, as will now be discussed.

Claim 1 recites the steps of "answering, by a first party, the incoming call at one of said plurality of cordless handsets" and "accepting said incoming call at another one of said plurality of cordless handsets, by said intercom receiving party." Accordingly, claim 1 requires that a call be (i) answered at a first cordless handset by a first party and then (ii) accepted at a second cordless handset by a second party.

As admitted by the Examiner on page 3 of the office action, Tsukada teaches a cordless phone having a base unit 2A and **only a single cordless handset 1A** and therefore fails to disclose a cordless telephone having a plurality of cordless handsets. Murata does teach a cordless phone having multiple cordless handsets. However, neither Tsukada nor Murata teaches a method for **transferring calls between cordless handsets**. Tsukada does not even involve multiple cordless handsets, and Murata teaches using cordless handsets only for making and receiving calls via an outside line or intercom calls between cordless handsets – but fails to teach, disclose, or even suggest transferring calls between cordless handsets. Nor is there even a suggestion in either reference of how a call could possibly be transferred from one cordless handset to another cordless handset.

Although Tsukada teaches transferring calls from a base unit to a cordless handset (e.g., col. 13, line 55, through col. 15, line 22), Tsukada's teachings are limited to a base unit and a cordless handset. Tsukada provides no teachings whatsoever regarding how to transfer calls between cordless handsets. Even though Murata teaches a cordless phone system having multiple cordless handsets, this fact alone is not enough to supply the missing teachings of **transferring calls between cordless handsets**, as required by the recitations of claim 1.

For reference, the portions of Murata cited by the Examiner that allegedly provide the teachings of **transferring calls between cordless handsets**, namely, FIGs. 1 and 2 and column 4, lines 12-29, of Murata, are reproduced below:

FIG. 1 of Murata:

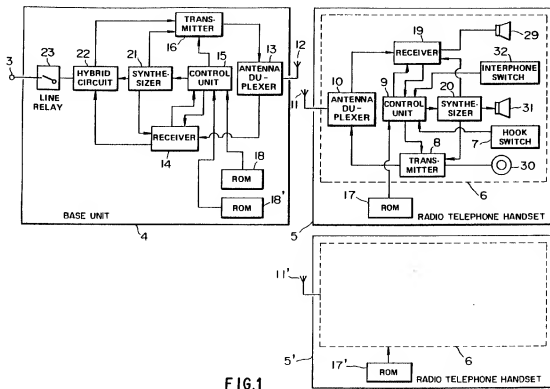


FIG. 1

FIG. 2 of Murata:

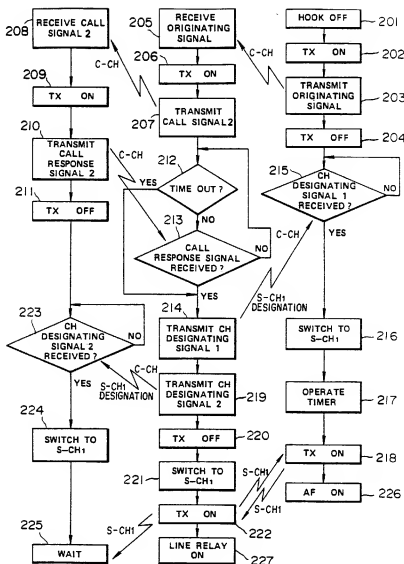


FIG. 2

Col. 4, lines 12-29, of Murata:

After sending the call signal 2 at step 207, at step 212 the base unit 4 executes a judgement as to whether a predetermined time has elapsed or not. When the result of the judgement shows that the predetermined time has not yet elapsed, that is not time out, the program is transferred to step 213 at which a judgement is made as to whether receiver 14 has received a call response signal 2 from radio telephone handset 5' or not. When the result of judgement at step 213 is NO, the program is returned to step 312. When result of judgement at step 212 shows a time out and when the result of judgement at step 213 shows receipt of a call response signal 2, the program is transferred to step 214. More particularly, when a predetermined time has elapsed after sending out a call signal 2 from the base unit 4, or when a call response signal 2 is received from radio telephone handset 5', the program is transferred to step 214.

As clearly seen from the portions of Murata reproduced above, these portions of Murata fail to teach, in any way, **transferring calls between cordless handsets**, nor how calls could possibly be transferred between cordless handsets. All that these portions of Murata teach is a base unit 4 attempting to make a connection with radio telephone handset 5¹ during the initiation of a telephone call from a cordless handset.

At best, the combination of Tsukada and Murata proposed by the Examiner, i.e., merely adding Murata's multiple cordless handsets to Tsukada, might result in the teaching of a cordless phone system in which a **base station can transfer calls from a base unit to either a first cordless handset or to a second cordless handset** – but the Applicant's teachings of transferring a call **from one cordless handset to the other** simply cannot be derived from any combination of these references.

Accordingly, no combination of Tsukada and Murata could possibly render claim 1 obvious.

Moreover, the motivation alleged by the Examiner for combining Tsukada and Murata, namely, "to [make it] easy for controlling an intercom connection among a plurality of the radio telephone handsets," does not make sense. The Examiner has presented no evidence whatsoever that somehow adding Murata's multiple cordless handsets to Tsukada would actually make it "easy" to control "an intercom connection among a plurality of the radio telephone handsets," as the Examiner alleged. Therefore, the motivation alleged by the Examiner is improper. There is no other motivation provided by the Examiner or found in the cited references, other than this improper motivation.

Since there is no proper motivation or suggestion in the art to combine Tsukada and Murata, these references cannot properly be combined to render claim 1, or any other claim of the present application, obvious. In view of the foregoing, the Applicant submits that it is improper to combine Tsukada and Murata to reject claim 1 as obvious. As such, the Applicant respectfully submits that claim 1 is allowable over Tsukada and Murata.

Even under the obviousness analysis provided by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401, 127 S. Ct. 1727 (2007), it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. Moreover, in her May 3, 2007 Memorandum to Technology Center Directors, Margaret A. Focarino, Deputy Commissioner for Patent Operations, clearly states that "in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." This necessity was confirmed in the *2010 KSR Guidelines Update* published by the USPTO on September 1, 2010 (Federal Register, Vol. 75, No. 169 at 53645), which reiterated that:

the 2007 KSR Guidelines and MPEP § 2143 state: "The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." MPEP § 2143. In *Ball Aerosol v. Limited Brands*, 555 F.3d 984 (Fed. Cir. 2009), the Federal Circuit offered additional instruction as to the need for an explicit analysis. The Federal Circuit explained, as is consistent with the 2007 KSR Guidelines, that the Supreme Court's requirement for an explicit analysis does not require record evidence of an explicit teaching of a motivation to combine in the prior art. [T]he analysis that "should be made explicit" refers not to the teachings in the prior art of a motivation to combine, but to the court's analysis * * *. Under the flexible inquiry set forth

by the Supreme Court, the district court therefore erred by failing to take account of “the inferences and creative steps,” or even routine steps, that an inventor would employ and by failing to find a motivation to combine related pieces from the prior art. *Ball Aerosol*, 555 F.3d at 993. The Federal Circuit’s directive in *Ball Aerosol* was addressed to a lower court, but it applies to Office personnel as well. When setting forth a rejection, Office personnel are to continue to make appropriate findings of fact as explained in MPEP §§ 2141 and 2143, and must provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. This requirement for explanation remains even in situations in which Office personnel may properly rely on intangible realities such as common sense and ordinary ingenuity.

In the present application, the Examiner has failed to identify any valid reason for combining Tsukada and Murata, and therefore, the §103 rejection is improper.

For all these reasons, the Applicant submits that claim 1 is allowable over the cited references. For similar reasons, the Applicant submits that claim 5 is also allowable over the cited references. Since claims 2, 19-22, 28, and 29 depend variously from claims 1 and 5, it is further submitted that those claims are also allowable over the cited references.

Claims 6-14 and 44-58

Claim 6 recites:

6. A cordless telephone system comprising:
a base station including first control circuitry for controlling operations at said base station; and
at least two cordless telephone handsets for communicating with said base station, each including second control circuitry for controlling operations at said cordless telephone handset;
said first and second control circuitry operating in response to initiation of an intercom communication at a first of said cordless telephone handsets to **place an active call at the first cordless telephone handset on hold during said intercom communication**, the intercom communication permitting voice communication between at least two of said cordless telephone handsets.

The Examiner acknowledged that Tsukada fails to disclose “at least two cordless handsets for communicating with said base station” and an “intercom communication permitting voice communication between at least two of said cordless handsets,” but alleged that Murata teaches these features, concluding that “it would have been obvious to one of ordinary skill in the art at the time [the] invention was made to apply the teaching of Murata to Tsukada to [make it] easy for controlling an intercom connection among a plurality of the radio telephone handsets.”

However, even the combined teachings of the Tsukada and Murata references are severely deficient and fail to render the Applicant’s claim 6 obvious, as will now be discussed.

Claim 6 recites that the first and second control circuitry “place an active call at the first cordless telephone handset on hold during said intercom communication” in response to the initiation of an intercom communication “permitting voice communication between at least two of said cordless telephone handsets.”

As fully discussed above regarding the rejection of claim 1, the combination of Tsukada and Murata fails to teach a method for transferring calls between cordless handsets. Similarly, neither reference teaches placing an active call at a first handset on hold during an intercom communication between the first handset and a second handset.

Tsukada does not even involve multiple cordless handsets, and Murata teaches using cordless handsets only for making and receiving calls via an outside line or intercom calls between cordless handsets – but fails to teach, disclose, or even suggest placing a call on hold at all, let alone placing an active call at a first handset on hold during an intercom communication between the first handset and a second handset.

Although Tsukada teaches placing a call on hold at a base station (e.g., col. 5, lines 17-21), Tsukada's teachings are limited to placing a call on hold at a base station, not at a cordless handset. Tsukada provides no teachings whatsoever regarding how to place a call on hold at a cordless handset. Thus, even though Murata teaches a cordless phone system having multiple cordless handsets, this fact alone is not enough to supply the missing teachings of **placing an active call at a first handset on hold during an intercom communication between the first handset and a second handset**, as required by the recitations of claim 6.

At best, the combination of Tsukada and Murata proposed by the Examiner, i.e., merely adding Murata's multiple cordless handsets to Tsukada, might result in the teaching of **a cordless phone system having multiple handsets, in which a base station can place calls on hold** – but the Applicant's teachings of **placing a call on hold at one of the cordless handsets during an intercom communication between cordless handsets** simply cannot be derived from any combination of these references.

Accordingly, no combination of Tsukada and Murata could possibly render claim 6 obvious.

Moreover, the motivation alleged by the Examiner for combining Tsukada and Murata, namely, "to [make it] easy for controlling an intercom connection among a plurality of the radio telephone handsets," does not make sense. The Examiner has presented no evidence whatsoever that somehow adding Murata's multiple cordless handsets to Tsukada would actually make it "easy" to control "an intercom connection among a plurality of the radio telephone handsets," as the Examiner alleged. Therefore, the motivation alleged by the Examiner is improper. There is no other motivation provided by the Examiner or found in the cited references, other than this improper motivation.

Since there is no proper motivation or suggestion in the art to combine Tsukada and Murata, these references cannot properly be combined to render claim 6, or any other claim of the present application, obvious. In view of the foregoing, the Applicant submits that it is improper to combine Tsukada and Murata to reject claim 6 as obvious. As such, the Applicant respectfully submits that claim 6 is allowable over Tsukada and Murata.

Even under the obviousness analysis provided by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401, 127 S. Ct. 1727 (2007), it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. Moreover, in her May 3, 2007 Memorandum to Technology Center Directors, Margaret A. Focarino, Deputy Commissioner for Patent Operations, clearly states that "in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the

manner claimed.” This necessity was confirmed in the 2010 *KSR Guidelines Update* published by the USPTO on September 1, 2010 (Federal Register, Vol. 75, No. 169 at 53645), which reiterated that:

the 2007 *KSR* Guidelines and MPEP § 2143 state: “The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” MPEP § 2143. In *Ball Aerosol v. Limited Brands*, 555 F.3d 984 (Fed. Cir. 2009), the Federal Circuit offered additional instruction as to the need for an explicit analysis. The Federal Circuit explained, as is consistent with the 2007 *KSR* Guidelines, that the Supreme Court’s requirement for an explicit analysis does not require record evidence of an explicit teaching of a motivation to combine in the prior art. [T]he analysis that “should be made explicit” refers not to the teachings in the prior art of a motivation to combine, but to the court’s analysis * * *. Under the flexible inquiry set forth by the Supreme Court, the district court therefore erred by failing to take account of “the inferences and creative steps,” or even routine steps, that an inventor would employ and by failing to find a motivation to combine related pieces from the prior art. *Ball Aerosol*, 555 F.3d at 993. The Federal Circuit’s directive in *Ball Aerosol* was addressed to a lower court, but it applies to Office personnel as well. When setting forth a rejection, Office personnel are to continue to make appropriate findings of fact as explained in MPEP §§ 2141 and 2143, and must provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. This requirement for explanation remains even in situations in which Office personnel may properly rely on intangible realities such as common sense and ordinary ingenuity.

In the present application, the Examiner has failed to identify any valid reason for combining Tsukada and Murata, and therefore, the §103 rejection is improper.

For all these reasons, the Applicant submits that claim 6 is allowable over the cited references. For similar reasons, claims 9, 12, 44, 49, and 54 are also allowable over the cited references. Since claims 7, 8, 10, 11, 13, 14, 45-48, 50-53, and 55-58 depend variously from claims 6, 9, 12, 44, 49, and 54, it is further submitted that those claims are also allowable over the cited references.

Conclusion

The Applicant submits therefore that the rejections of claims under Section 103 have been overcome.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

Fees

During the pendency of this application, the Commissioner for Patents is hereby authorized to charge payment of any filing fees for presentation of extra claims under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17 or credit any overpayment to Mendelsohn, Drucker, & Associates, P.C. Deposit Account No. 50-0782.

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR § 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

Date: January 3, 2011
Customer No. 46900
Mendelsohn, Drucker, & Associates, P.C.
1500 John F. Kennedy Blvd., Suite 405
Philadelphia, Pennsylvania 19102

/Kevin M. Drucker/
Kevin M. Drucker
Registration No. 47,537
Attorney for Applicant
(215) 557-6657 (phone)
(215) 557-8477 (fax)